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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

GREG BENSON, ET AL.

SERIAL NO: 09/321,386

FILED: MAY 27, 1999

FOR: METHOD AND SYSTEM FOR
MANAGING A DATA OBJECT SO AS TO
COMPLY WITH PREDETERMINED
CONDITIONS FOR USAGE

:

: EXAMINER: VON BUHR, M.

:

: GROUP ART UNIT: 2125

:

37 CFR 1.607 REQUEST FOR
AN INTERFERENCE WITH TWO PATENTS

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

I. 37 CFR 1.607(a)(1)

The patents are U.S. patent Nos. 5,982,891 and 6,253,193 issued on November 09, 1999 and June 26, 2001, respectively, and naming Ginter et al. as inventors. The assignee at issue was InterTrust Technologies Corporation for both patents.

II. Relevant Field and Level of Ordinary Skill in the Art

The relevant field is digital rights management (DRM). That field is further defined in CEN/ISSS Digital Rights Management Draft Report, Exhibit A. See paragraph (7) of Exhibit B.

A person of ordinary skill in the art of DRM in the 1995 to 1996 timeframe had 5 to 7 years experience in audio/video compression technology and 1 to 3 years experience in Internet transport and e-commerce. Further, a person of ordinary skill in the art of DRM in

that timeframe was knowledgeable concerning international copyright laws and means/methods for protecting copyrighted content. See paragraph (8) of Exhibit B.

III. 37 CFR 1.607(a)(2)

A. Proposal

Applicants propose the following count, which is in the format approved by the Commissioner in Orikasa v. Oonishi, 10 USPQ2d 1999, 2003 (Comm'r 1990), and Davis v. Uke, 27 USPQ2d 1180, 1188 (Comm'r 1993):

Claim 7 in the '193 patent

OR

Claim 49 in the instant application.

Claim 7 in the '193 patent recites:

A method comprising:

receiving a digital file stored on a video disk;

storing said digital file in a first secure memory of a first device;

storing budget information associated with said digital file in a secure database stored on said first device, said budget information relating to permitted uses of said digital file and including at least one control, said budget information having been received on a video disk;

determining whether said digital file may be copied and stored on a second device based on said at least one control;

if said at least one control allows at least a portion of said digital file to be copied and stored on a second device, copying at least a portion of said digital file;

transferring at least a portion of said digital file to a second device, after checking said budget to determine if said transferring step is authorized;

including a memory and an audio and/or video output;

storing said digital file in said memory of said second device; and

rendering said digital file through said output.

Claim 49 of the instant application depends from claim 48. Claim 48 recites:

A method of managing a data object so as to comply with control conditions for usage of the data object, comprising:

storing a data object in the memory of a data object provider processor;

providing a variable number of control conditions for usage of the data object;
and

providing a set of control data for the data object based on the variable number of control conditions for usage, the set of control data comprising at least one or more usage control elements defining usage of the data object which comply with the variable number of control conditions.

Claim 49 recites:

The method of claim 48, additionally comprising:

transmitting the data object and the set of control data into a data processor;
and

checking, in response to a request by a user for usage of the data object, whether the requested usage complies with the usage defined by the at least one usage control element of the set of control data; and

complying with the usage defined by the at least one usage control element of the set of control data so as to enable the requested usage.

Claims 7 and 49 do not recite identical language. However, Applicants submit that (1) the subject matter defined by claim 7 would have been obvious to a person of ordinary skill in the art during the 1995 to 1996 timeframe in view of the subject matter defined by claim 49 and (2) that the subject matter defined by claim 49 would have been obvious to a person of ordinary skill in the art during the 1995 to 1996 timeframe in view of the subject matter defined by claim 7. See paragraphs (9)-(12) of Exhibit B.

B. The subject matter defined by claim 7 would have been obvious in view of the subject matter defined by claim 49

Claim 7 of the '193 patent recites the step of "receiving a digital file stored on a video disk" Similarly, claim 48 of the instant application recites the step of "storing a data object in the memory of a data object provider processor" Applicants submit that it was well known during the 1995 to 1996 time frame that a digital file could be stored on a video

disk (e.g., a video compact disk or laser disk) and transferred to a memory of a processor. Hence, the receiving step of claim 7 does not render the subject matter defined by claim 7 non-obvious in view of the subject matter defined by claim 49. See paragraph (13) of Exhibit B.

Claim 7 of the '193 patent further recites the step of "storing said digital file in a first secure memory of a first device" Claim 48 of the instant application recites the step of "storing a data object in the memory of a data object provider processor" Claim 48 does not provide that the memory of the data object provide is secure. However, tamper-proof data storage was well known during the 1995 to 1996 time frame. See U.S. patent No. 5,237,616 to Abraham et al (hereinafter referred to as "the Abraham patent").¹ Further, it was well known during the 1995 to 1996 timeframe to provide a secure memory by encrypting the data therein. Hence, it would have been obvious during the 1995 to 1996 time frame to store a data object in a secure memory of the data object provider in order to prevent the user from tampering with the data object. See paragraph (14) of Exhibit B.

Claim 7 of the '193 patent further recites "storing budget information associated with said digital file in a secure database stored on said first device, said budget information *relating to permitted uses of said digital file and including at least one control*"² Similarly, claim 48 recites the step of "providing a set of control data for the data object based on the variable number of control conditions for usage, the set of control data comprising at least one or more usage control elements defining usage of the data object which comply with the variable number of control conditions." Applicants submit that there is no patentable distinction between these two claim recitations. See paragraph (15) of Exhibit B.

¹A copy of the Abraham patent is Exhibit C.

²Italics added for emphasis.

Claim 7 of the '193 patent further recites "said budget information having been received on a video disk" Claim 49 of the instant application does not expressly define this limitation. However, Applicants first point out that the "a video disk" appears twice in claim 7. Hence, it is unclear whether the digital file and the budget information are both stored on the same video disk or distinct video disks. In any event, Applicants submit that storing content and control information on a single medium (e.g., a CD) was well known during the 1995 to 1996 time frame. See U.S. patent No. 5,453,968 to Veldhuis et al. (hereinafter referred to as "the Veldhuis patent").³ Consequently, it would have been obvious to a person of ordinary skill in the art during the 1995 to 1996 time frame to store control information and content on a single medium in order to regulate copying of the content. See paragraph (16) of Exhibit B.

Claim 7 further recites the step of "determining whether said digital file may be copied and stored on a second device based on said at least one control" Similarly, claim 49 recites the step of "checking, in response to a request by a user for usage of the data object, whether the requested usage complies with the usage defined by the at least one usage control element of the set of control data" Applicants submit that there is no patentable distinction between these two claim recitations. See paragraph (17) of Exhibit B.

Claim 7 further recites the step of "if said at least one control allows at least a portion of said digital file to be copied and stored on a second device, copying at least a portion of said digital file" Similarly, claim 49 recites the step of "complying with the usage defined by the at least one usage control element of the set of control data so as to enable the requested usage." Applicants submit that there is no patentable distinction between these two claim recitations. See paragraph (18) of Exhibit B.

³A copy of the Veldhuis patent is Exhibit E.

Claim 7 further recites the step of “transferring at least a portion of said digital file to a second device, after checking said budget to determine if said transferring step is authorized” Similarly, claim 49 recites “transmitting the data object and the set of control data into a data processor; and checking ... whether the requested usage complies” Claim 49 does not expressly define when the checking step should occur relative to the transmitting step.

Hence, claim 49 can be interpreted such that the checking step occurs before the transmitting step or vice versa. Further, Applicants submit that it was well known during the 1995 to 1996 time frame to transmit a data object after checking that a requested usage complies with a defined usage. Hence, it would have been obvious to a person of ordinary skill in the art during the 1995 to 1996 time frame to transmit a data object after checking that a requested usage complies with a defined usage. See paragraphs (19) and (20) of Exhibit B.

Claim 7 further recites “including a memory and an audio and/or video output” Applicants first point out that claim 7 is a method claim and that this limitation is clearly directed to an apparatus. Applicants further point out that it is unclear from claim 7 whether the first device and/or the second device includes “a memory and an audio and/or video output.” Applicants concede that claim 49 does not expressly define a second device including a memory and an audio and/or video output. However, it was well known during the 1995 to 1996 time frame that in order to use the data object that at least one of an audio or video output would have been necessary as most applications were geared towards digital audio. Hence, it would have been obvious to modify the method defined by claim 48 to include a second device including at least one of an audio or video output. See paragraph (21) of Exhibit B.

Claim 7 further recites the step of “storing said digital file in said memory of said second device” Claim 49 of the instant application recites the step of “transmitting the data object and the set of control data into a data processor” Applicants submit that it is

inherent that the data processor is associated with memory. Hence, there is no patentable distinction between these two claim recitations. See paragraph (22) of Exhibit B.

Finally, claim 7 recites the step of “rendering said digital file through said output.” As discussed above with regard to the output feature of claim 7, Applicants submit that it would have been obvious to modify the method defined by claim 48 to render the data object through an output. See paragraph (23) of Exhibit B.

Consequently, the subject matter defined by claim 7 defines the same patentable subject matter as claim 49, and one-half of the required two-way obviousness test is satisfied. See paragraph (24) of Exhibit B.

C. The subject matter defined by claim 49 would have been obvious in view of the subject matter defined by claim 7

Claim 48 recites the step of “storing a data object in the memory of a data object provider processor” Claim 7 recites the step of “storing said digital file in a first secure memory of a first device” Applicants submit that this claim 48 recitation is broader than this claim 7 recitation and that the claim 48 recitation wholly encompasses the claim 7 recitation. See paragraph (25) of Exhibit B.

Claim 48 further recites the step of “providing a variable number of control conditions for usage of the data object” Similarly, claim 7 recites “storing budget information ... relating to permitted uses of said digital file” Applicants submit that there is no patentable distinction between these two claim recitations. See paragraph (26) of Exhibit B.

Claim 48 further recites the step of “providing a set of control data for the data object based on the variable number of control conditions for usage, the set of control data comprising at least one or more usage control elements defining usage of the data object which comply with the variable number of control conditions.” Similarly, claim 7 recites the step of “storing budget information associated with said digital file in a secure database

stored on said first device, said budget information *relating to permitted uses of said digital file* and including *at least one control*”⁴ Applicants submit that there is no patentable distinction between these two claim recitations. See paragraph (27) of Exhibit B.

Claim 49 recites the step of “transmitting the data object and the set of control data into a data processor” Claim 7 recites the step of “transferring at least a portion of said digital file to a second device” Claim 7 does not expressly define that control data is transferred to the second device. However, Applicants submit that it was known during the 1995 to 1996 time frame to transmit control data in conjunction with content data. See the Veldhuis patent. Consequently, it would have been obvious to a person of ordinary skill in the art during the 1995 to 1996 time frame to transfer the digital file *and* control data to a second device. See paragraph (28) of Exhibit B.

Claim 49 further recites the step of “checking, in response to a request by a user for usage of the data object, whether the requested usage complies with the usage defined by the at least one usage control element of the set of control data” Claim 7 recites the step of “determining whether said digital file may be copied and stored on a second device based on said at least one control” Claim 7 does not expressly define that the determining step is completed in response to a user request for usage. However, the transferring step of claim 49 implies that a user requested the transfer since the digital file is stored in a secure database. Hence, the checking step of claim 49 would have been obvious in view of the determining step of claim 7. See paragraph (29) of Exhibit B.

Finally, claim 49 recites the step of “complying with the usage defined by the at least one usage control element of the set of control data so as to enable the requested usage.” Similarly, claim 7 recites the step of “if said at least one control allows at least a portion of said digital file to be copied and stored on a second device, copying at least a portion of said

⁴Italics added for emphasis.

digital file” Applicants submit that there is no patentable distinction between these two claim recitations. See paragraph (30) of Exhibit B.

Hence, the subject matter defined by claim 49 of the instant application would have been unpatentable (obvious) over the subject matter of claim 7 and the second-half of the required two-way obviousness test is satisfied. See paragraph (31) of Exhibit B.

IV. 37 CFR 1.607(a)(3)

Claims 1-72 in the ‘193 patent correspond to the proposed count. Claims 1-6 and 8-18 merely provide further detail regarding the nature of the control and the type of digital file being transferred. Claims 19-72 merely provide an extra level of security by incorporating a clearinghouse. See paragraph (32) of Exhibit B.

Claims 26-31 of the ‘891 patent correspond to the proposed count. Those claims are directed to a method for combining data items into a composite data item. See, for example, claim 31 of the instant application.

V. 37 CFR 1.607(a)(4)

Claims 1-22 and 25-53 of the instant application correspond to the proposed count.

Claims 30-51, 54, and 56-69 of the ‘606 application correspond to the proposed count.

VI. 37 CFR 1.607(a)(5)

37 CFR 1.607(a)(5) is inapplicable because all of the claims of the instant application and the ‘606 application were in the application and deemed allowable prior to the filing of this request.

VII. 37 CFR 1.607(a)(6)

During a November 05, 2003 telephone conference held between Administrative Patent Judge Lee, counsel for InterTrust, and the undersigned, it was agreed that InterTrust

reserved the right to challenge Applicants' claims under 35 USC 135(b) if an interference is declared.

VIII. REQUEST FOR THE BENEFIT OF THE FILING DATES OF APPLICANTS' PRIORITY APPLICATIONS

Applicants claim priority under 35 USC 120 based upon U.S. application serial No. 08/594,811, which was filed on January 31, 1996. The '811 application matured into U.S. patent No. 5,845,281. Applicants further claim priority under 35 USC 120 based upon the '606 application, which was filed on October 01, 1998. The '606 application is a continuation of the '811 application and the instant application is a continuation of the '606 application. Applicants are entitled to the benefit of the filing dates of their earlier filed applications for interference purposes if the count reads on at least one adequately disclosed embodiment in the earlier application.⁵ Assuming that the examiner recommends to the board applicants' proposed count, applicants clearly meet that standard. This is so because this application is a continuation application from the '811 and '606 applications. Consequently, applicants' earlier filed U.S. application has the same disclosure as the instant application.

Furthermore, Applicants claim priority under 35 USC 119 for both the '386 application and the instant application based upon Swedish application 9500355-4, which was filed on February 01, 1995.⁶ That applicants' proposed count reads on at least one adequately disclosed embodiment in the Swedish priority application is shown below.

48. A method of managing a data object so as to comply with control conditions for usage of the data object, comprising:	See Figures 1, 3, and 5
storing a data object in the memory	Figure 1 elements 11 and 24 and

⁵Weil v. Fritz, 572 F.2d 856, 865-66 n.16, 196 USPQ 600, 608 n.16 (CCPA 1978).

⁶A copy of the Swedish application, which was originally written in English, is Exhibit F.

of a data object provider processor;	Figure 3.
providing a variable number of control conditions for usage of the data object; and	Figure 5 step 7050 and page 12 lines 7-21.
providing a set of control data for the data object based on the variable number of control conditions for usage, the set of control data comprising at least one or more usage control elements defining usages of the data object which comply with the variable number of control conditions.	Figure 5 step 7050 and page 12 lines 7-21.
49. The method of claim 48, additionally comprising:	
transmitting the data object and the set of control data into a data processor; and	See Figure 10 and page 14 line 17 - page 15 line 2.
checking, in response to a request by a user for usage of the data object, whether the requested usage complies with the usage defined by the at least one usage control element of the set of control data; and	See Figure 11 and page 15 lines 5-33.
complying with the usage defined by the at least one usage control element of the set of control data so as to enable the requested usage	See Figure 11 and page 15 lines 5-33.

IX. 37 CFR 1.608

37 CFR 1.608 is irrelevant since the effective filing date of this application and the '606 application (i.e., February 01, 1995) precedes the effective filing date of the target patent (i.e., February 13, 1995).

For the foregoing reasons, the party Benson should be the senior party in the requested interference.

Respectfully submitted,



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